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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NATALINO GIORGIO, ALBERT VAN DER WERF, and
PAUL EUGENE RICHARD LIPPENS

Appeal 2009-004241
Application 09/801,080¹
Technology Center 2100

Decided: January 11, 2010

Before JAY P. LUCAS, CAROLYN D. THOMAS, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed March 7, 2001. The real party in interest is Koninklijke Philips Electronics N.V.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-5, which are all the claims remaining in the application, as claims 6 and 7 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

Appellants invented a system and method for operating a data processing device. (Spec. 1, ll. 2-3.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-5. Claims 1 and 4 are independent claims. Claim 1 is illustrative:

1. A data processing device, comprising a master controller, a first functional unit including a slave controller, a second functional unit, and a common memory means shared by the first and second functional units, the data processing device being programmed for executing an instruction by the first functional unit, execution of said instruction involving input/output operations by the first functional unit, wherein said execution involves at least one of: output data of the first functional unit being processed by the second functional unit during execution of said instruction, and the input data to the first functional unit being generated by the second functional unit during execution of said instruction.

C. REFERENCES

The references relied upon by the Examiner as evidence in rejecting the claims on appeal are as follows:

McNeill US 4,876,643 Oct. 24, 1989

O'Connor US 6,266,766 B1 Jul. 24, 2001

D. REJECTIONS

The Examiner entered the following rejections which are before us for review:

- (1) Claims 1-5 are rejected under 35 U.S.C. § 102(b) as being anticipated by McNeill; and
- (2) Claims 1-5 are rejected under 35 U.S.C. § 102(e) as being anticipated by O'Connor

II. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

McNeill

McNeill discloses “when the master processor receives a search request it assigns the execution of the search to a free slave processor.” (Col. 4, ll. 35-37.)

III. PRINCIPLES OF LAW

“[T]he [E]xaminer bears the initial burden, on review of the prior art or on any ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In an appeal from a rejection for anticipation, the Appellant must explain which limitations are not found in the reference. *See Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (“[W]e expect that the Board’s anticipation analysis be conducted on a limitation by limitation basis, with specific fact findings for each *contested* limitation and satisfactory explanations for such findings.”)(emphasis added). *See also In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (noting Appellant’s burden on appeal to show error in an obviousness rejection).

The treatment of replies in appeals to the Board is consistent with the role of replies in appeals generally. Although the procedural rules governing appeals before the Board are separate and distinct from the procedural rules of an Article III Court of Appeals, the explanation by our reviewing court of the function of a Reply Brief is instructive:

This court has stated that under Fed. R. App. P. 28(c)² a reply brief should “reply to the brief of the appellee” and “is not the appropriate place to raise, for the first time, an issue for appellate review.” *Amhil Enterprises Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1563 (Fed. Cir. 1996); *see also Regents of the Univ. of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1565-66 (Fed. Cir. 1997)(footnote added). . . .

² Fed. R. App. P. 28(c) reads in relevant part, “[t]he appellant may file a brief in reply to the appellee’s brief.”

There are cogent reasons for not permitting an appellant to raise issues or arguments in a reply brief. Among them are the unfairness to the appellee who does not have an opportunity to respond and the added burden on the court that a contrary practice would entail. As the Tenth Circuit put it, permitting an appellant to raise new arguments in a reply brief “would be unfair to the court itself, which without the benefit of a response from appellee to an appellant’s late-blooming argument, would run the risk ‘of an improvident or ill-advised opinion, given [the court’s] dependence . . . on the adversarial process for sharpening the issues for decision.’” *Headrick* [v. *Rockwell Int’l Corp.*,] 24 F.3d [1272,] 1278 (10th Cir. 1994)] (quoting *Herbert v. Nat’l Academy of Sciences*, 974 F.2d 192, 196 (D.C. Cir. 1992)).

Carbino v. West, 168 F.3d 32, 34-35 (Fed. Cir. 1999).

IV. ANALYSIS

Grouping of Claims

In the principal Brief, Appellants argue claims 1-5 as a group (App. Br. 6-7). We will, therefore, treat claims 1-5 as standing or falling together. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

Anticipated by O’Connor

We first consider the Examiner’s rejection of the claims 1-5 under 35 U.S.C. § 102(e) as being anticipated by O’Connor.

First we note that while we appreciate Appellants’ characterization of the O’Connor reference (App. Br. 6), Appellants have not clearly explained which limitations are not found in the cited reference. Instead, Appellants

arguments appear to be limited to what O'Connor teaches rather than how the Examiner erred.

In response to the Appeal Brief, the Examiner must make several assumptions as to what exactly is being argued. For example, the Examiner assumes that Appellants are arguing that O'Connor fails to teach "concurrently execution" [sic], a limitation which Examiner finds is not recited in the claims (Ans. 8). While the Examiner's response section of the Answer has made assumptions as to what Appellants' arguments are directed towards, we will not. "It is not the function of [the U.S. Court of Appeals for the Federal Circuit] to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." *In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991). Similarly, it is not the function of this Board to examine claims in greater detail than argued by an Appellant, looking for distinctions over the prior art. It is Appellants' burden to show error in an anticipation rejection. Here, we find that Appellants have failed to specifically identify how the Examiner erred.

Secondly, we find that while the Principal Brief on Appeal lacks any specific arguments on how the Examiner erred, the Reply Brief attempts to cure this deficiency by presenting greater substance in this regard. However, this situation causes us to ponder the question of whether arguments that could have been presented in the Principal Brief on Appeal, but were not, may be presented in the Reply Brief in the absence of a showing of good cause. We conclude that the regulations set out in 37 C.F.R. § 41, *Practice Before the Board of Patent Appeals and Interferences*, do not require the Board to consider such belated arguments.

The Examiner's statement of rejection in the Answer (Ans. 5-8) appears to be substantially the same as, if not identical to, the statement of the rejection in the Final Rejection (which incorporates by reference the non-final office action dated September 30, 2005). Moreover, the Examiner did not make any additional findings of fact regarding O'Connor in the Response to Argument section of the Answer.

Appellants, however, raised new arguments against the rejection in the Reply Brief (Reply Br. 2-6), yet, did not explain what "good cause" there might be to consider these new arguments. On this regard, Appellants' new arguments are belated.

The purpose of the principal Brief on Appeal is to show that the Examiner erred in rejecting the claims. The formal requirements of the Appeal Brief are set out in Board Rule 37³, which, *inter alia*, sets the formal requirements for the nature of the argument:

Argument. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. *Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 [providing for a Reply Brief] will be refused consideration by the Board, unless good cause is shown* (emphasis added).

37 C.F.R. § 41.37(c)(1)(vii) (2007).⁴ This section requires Appellants to put forward a complete argument. Any bases for asserting error, whether factual or legal, which are not raised in the principal Brief are waived.

³ "In proceedings before the Board, a party may cite '§ 41.x' as 'Board Rule x'." 69 Fed. Reg. 49960, 49961 (Aug. 12, 2004) (Notice of Final Rule Making).

⁴ See also 69 Fed. Reg. at 50010.

Rule 41, which provides for Reply Briefs, does not specify the content of the Reply Brief, other than to state that “[a] reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.” 37 C.F.R. § 41.41(a)(2) (2007). The purpose of a Reply Brief is to ensure the Appellant the opportunity to have the last word on an issue raised by the Examiner. The Reply Brief enables the Appellant to address any new grounds of rejection the Examiner may have raised in the Answer, or to address changes or developments in the law that may have occurred after the principal Brief was filed. The Reply Brief is *not* an opportunity to make arguments that could have been made during prosecution, but were not. Nor is the Reply Brief an opportunity to make arguments that could have been made in the principal Brief on appeal to rebut the Examiner’s rejections, but were not.

Giving cognizance to belated arguments in a Reply Brief would vitiate the force of the requirement in Board Rule § 41.37(c)(1)(vii) that “[a]ny arguments or authorities not included in the brief . . . will be refused consideration by the Board, unless good cause is shown.” The reference in that section to the “reply brief filed pursuant to § 41.41” does not create a right for the Appellant to raise an argument in the Reply Brief that could have been raised in the principal Brief but was not. Rather, that reference merely puts Appellants on notice that arguments that could be made in the Reply Brief, but are not, are waived.

In any event, the Appellants can have a full and fair opportunity to raise additional issues and to provide additional evidence by way of refiling the application under an appropriate provision of 37 C.F.R. § 1.53, or by seeking continued prosecution under § 1.114. It is in no way unfair to

require Applicants for patents, including Appellants to the Board, to present their best arguments in a timely fashion. Belated arguments, if addressed, impose costs on the Agency (specifically on the Examiner, the Technical Center Directors, and the Board), which in turn impose costs on the public (most directly, on other Applicants and Appellants, who must wait longer for consideration of their applications and appeals; and indirectly, on the general public, which must wait longer for the benefits provided by a healthy and vigorous patent system). Properly interpreted, the Rules do not require the Board to take up a belated argument that has not been addressed by the Examiner, absent a showing of good cause.

Thus, Appellants have not persuaded us of error in the Examiner’s conclusion of anticipation for representative claim 1 under O’Connor. Therefore, we affirm the Examiner’s § 102 rejection of representative claim 1 and of claims 2-5, which fall therewith.

Anticipated by McNeill

We next consider the Examiner’s rejection of the claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by McNeill.

Appellants contend that in McNeill “a search is a computing task. It is not ‘an instruction’ as set forth in the present claims.” (App. Br. 7.) No other discernible arguments were found in the principal Brief.

The Examiner found that “[a] task can be single instruction task or multi-instructions task. An instruction itself is a task. . . . [A]ppellant[s]’ claimed scope is not directed to the distinction between an instruction and a task.” (Ans. 9.)

Issue: Have Appellants shown that the Examiner erred in finding that McNeill discloses executing instructions?

Appellants' arguments seem to suggest that the claimed "instruction" is distinguishable from McNeill's "computing task" which executes a series of instructions in sequence (App. Br. 6). In response, the Examiner found that "an instruction itself is a task." We agree.

Appellants' limited argument even admits that a task includes a series of instructions. We further add that Appellants' contention fail to show how executing an instruction is distinguishable from executing a series of instructions. The mere fact that the prior art does more than what is claimed (executing a series of instruction verses executing a single instruction) does not dismiss the fact that one or more instructions are being executed.

McNeill discloses executing a search request, e.g., instructions (FF).

Regarding the Reply Brief, Appellants again attempt to enter belated arguments regarding this issue. As noted *supra*, any bases for asserting error, whether factual or legal, that are not raised in the principal Brief are waived. The Rules do not require the Board to take up a belated argument that has not been addressed by the Examiner, absent a showing of good cause. Again, for similar reasons given above, we shall not address such new arguments.

Thus, Appellants have not persuaded us of error in the Examiner's conclusion of anticipation for representative claim 1 under McNeill. Therefore, we affirm the Examiner's § 102(b) rejection of representative claim 1 and of claims 2-5, which fall therewith.

V. CONCLUSIONS

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-5.

Thus, claims 1-5 are not patentable.

VI. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-5.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

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